

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Andrew ROUSE, *et al.*
SERIAL NUMBER: 09/750,302 EXAMINER: Kenneth Coulter
FILING DATE: December 29, 2000 ART UNIT: 2141
FOR: SYSTEM AND METHOD FOR PROVIDING CUSTOMIZABLE OPTIONS ON A
WIRELESS DEVICE

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed January 25, 2007 ("the Examiner's Answer"), Appellants respectfully submit a Reply Brief pursuant to 37 C.F.R. § 41.41.

It is not believed that any fees are due in this case. However, the Director is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No. 033975 (**Ref. No. 042846-0312814**).

STATUS OF CLAIMS

Pending: Claims 21-40 are pending.

Cancelled: No claims are cancelled.

Rejected: Claims 21-40 stand rejected.

Allowed: No claims have been allowed.

On Appeal: The rejections of claims 21-40 under 35 U.S.C. § 102(e) is
appealed.

GROUND OF THE REJECTION TO BE REVIEWED ON APPEAL

Claims 21-40 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,076,109 to Kikinis (hereinafter "Kikinis"). Claims 21-40 stand rejected under 35 U.S.C. § 102 (e) as allegedly being anticipated by U.S. Patent Application Publication No. 2002/0024536 to Kahan *et al.* (hereinafter "Kahan").

ARGUMENT

I. REJECTIONS BASED ON KAHAN

The rejections of claims 21-40 under 35 U.S.C. § 102(e) as allegedly being anticipated by Kahan are legally erroneous at least because Kahan does not disclose all of the features of the claimed invention.

A. Claims 21, 22, 24, 26, 27, 29, 31, 32, 34, 36, 37, and 39

For example, independent claim 21 recites a method of formatting content for a mobile wireless client device *“based on a form that is used to display content on a desktop computer.”* The method includes the features of *“providing a mobile design element that corresponds to the form and is associated with the mobile wireless client device; [and] formatting the content according to the mobile design element.”* Claim 36 recites a storage medium for storing machine readable code that is executable to provide features similar to those cited above in claim 21. Claims 26 and 31 recite systems for formatting content for a mobile wireless client device that include subject matter similar to the subject matter of claim 21 provided above. Kahan does not disclose at least these features. As was discussed above, among other things, these features enable the user receive information on the mobile wireless client device in a format similar to the format in which the information would be presented to the user on a desktop computer.

In the Examiner's Answer, the Examiner has responded to Applicants' argument that the cited portions of Kahan do not include at least the features of the claimed invention provided above (see, e.g., the Appeal Brief, pgs. 10-13) by citing several additional passages of Kahan (e.g., paragraphs 14 and 70-78), and by alleging that the generic action menu of Figure 6 of Kahan is analogous to the claimed “form.” The Examiner's Answer, pg. 13. As can be seen in Figure 6 of

Kahan, provided below for convenience, the action menu relied on by the Examiner is merely a list of actions that a user is enabled to select from a mobile terminal for execution on the mobile terminal. Kahan, par. 92. In contrast, the claim language provided above clearly states that the "form" of the claimed invention is "*a form that is used to display content on a desktop computer.*" The action menu, and the actions included therein, that the Examiner refers to as providing a teaching of the claimed "form" does not relate in any way to the form for displaying content, and in particular does not appear to be relevant to a form for displaying content on a desktop computer (as opposed to a mobile terminal). The Examiner's assertion that the action menu illustrated in Figure 6 of Kahan is analogous to the claimed "form" constitutes legal error.

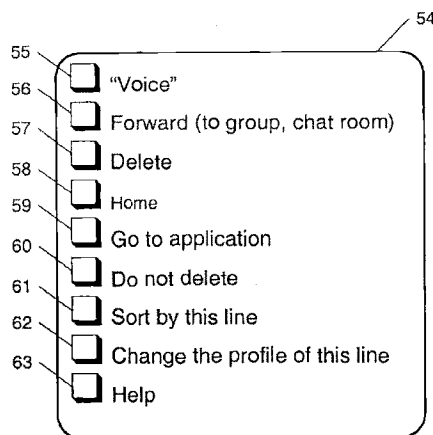


FIG. 6

The Examiner argues that the specification of the instant application supports the characterization of the generic menu of Kahan as a "form" as recited in, for example, claim 21. The Examiner's Answer, pgs. 13 and 14. In particular, the Examiner relies on paragraph 71 of the instant application, which reads as follows:

Varying fields may be supported in a form or subform, such as rich text, text, date/time, number, **checkbox**, radio button, listbox, authors, names, readers and other fields. Rich text fields may be

treated as simple text fields when sent to a mobile device where the text may be used and any embedded objects may be ignored or otherwise suppressed. However, attachments and other objects may be addressed. For example, when an attachment appears in a rich text field, a text replacement string may be substituted for the attachment in the text stream sent to the mobile device. Rich text fields in a wireless access application may also be assigned a truncation property, where a predetermined number of bytes of field (or number of characters) contents may be sent to the mobile device.
Emphasis as provided at page 14 of the Examiner's Answer.

The Examiner states that the disclosure that a form may support a "checkbox" provides a basis for the Examiner's supposition that an action menu that enables a user to select an action from a list of actions is analogous to "*a form that is used to display content on a desktop computer.*" This is an inaccurate reading of paragraph 71. The portion of paragraph 71 to which the Examiner is referring (e.g., the portion that recites a "checkbox") is merely a recitation of some examples of the myriad of different manifestations in which information may be displayed to a user via the interface of a desktop computer according to a form. This passage actually emphasizes that a single "form," corresponding to a desktop computer, may implement one or more different manifestations of content to display different types of content to a user on the desktop computer. Each of the individual manifestations of content on the computer used to display information (e.g., "rich text, text, date/time, number, checkbox, radio button, listbox, etc.") are a function of the "form," which dictates the manner content is displayed on the desktop computer. Assuming that the generic action menu was analogous to a "checkbox" (Applicants submit that it is not), and assuming that the generic action menu was for display on a desktop computer (it is not disclosed in Kahan as such), the generic action menu would still simply be a manifestation of content, and would not be analogous to the form that dictates such manifestations. Therefore, the section of the specification of the instant application that is cited by the Examiner (paragraph 71) actually supports Applicants' position that the citation of the generic action menu shown in Figure 6 of

Kahan by the Examiner as being analogous to the claimed "form" constitutes legal error.

Accordingly, the cited sections of Kahan do not clearly and unambiguously disclose each and every feature of the claimed invention. For at least this reason the rejections of claims 21, 26, 31, and 36 based on the cited sections of Kahan are legally erroneous and should be overturned.

Further, claims 22, 24, 27, 29, 32, 34, 37, and 39 depend from corresponding ones of claims 21, 26, 31, and 36. Therefore, the rejections of these claims based on Kahan should be withdrawn based on their dependency, as well as for the features that they recite individually.

B. Claims 23, 28, 33, and 38

Claims 23, 28, 33, and 38 depend from independent claims 21, 26, 31, and 36, respectively. Therefore, the rejections of claims 23, 28, 33, and 38 based on Kahan should be overturned at least for the reasons presented above, as well as for the features that they recite individually. For example, claims 23, 28, 33, and 38 are allowable over the cited portions of Kahan at least for the reasons presented in the Appeal Brief at pages 13 and 14.

C. Claims 25, 30, 35, and 40

Claims 25, 30, 35, and 40 depend from independent claims 21, 26, 31, and 36, respectively. Therefore, the rejections of claims 25, 30, 35, and 40 based on Kahan should be overturned at least for the reasons presented above, as well as for the features that they recite individually. For example, claims 25, 30, 35, and 40 are allowable over the cited portions of Kahan at least for the reasons presented in the Appeal Brief at pages 14 and 15.

II. REJECTIONS BASED ON KIKINIS

The rejections of claims 21-40 under 35 U.S.C. § 102(e) as allegedly being anticipated by Kikinis are legally erroneous at least because Kikinis does not disclose all of the features of the claimed invention.

A. Claims 21, 22, 24, 26, 27, 29, 31, 32, 34, 36, 37, and 39

For example, independent claim 21 recites a method of formatting content for a mobile wireless client device *“based on a form that is used to display content on a desktop computer.”* The method includes the features of *“providing a mobile design element that corresponds to the form and is associated with the mobile wireless client device; [and] formatting the content according to the mobile design element.”* Claim 36 recites a storage medium for storing machine readable code that is executable to provide features similar to those cited above in claim 21. Claims 26 and 31 recite systems for formatting content for a mobile wireless client device that include subject matter similar to the subject matter of claim 21 provided above. Kikinis does not disclose at least these features. Among other things, these features enable the user receive information on the mobile wireless client device in a format similar to the format in which the information would be presented to the user on a desktop computer.

In the Appeal Brief, Applicant presented evidence in support of the argument that the previously cited sections of Kikinis do not disclose at least the features of the claimed invention recited above. The Appeal Brief, pgs. 5-7. The Examiner has responded to these arguments by citing additional portions of Kikinis (e.g., FIG. 2; col. 9, lines 55-58; and col. 10, lines 31-36), and has alleged that an ID that identifies a particular wireless field unit to a Proxy-Server, as discussed in these portions, is analogous to *“a form that is used to display content on a desktop computer.”* The Examiner's Answer, pgs. 10, 11, and 15-17. In particular, the Examiner argues that

Kikinis discloses a user ID entered by the user that is sent to a Proxy-Server, "wherein this ID 'establishes the size and resolution of the hand-held's display.'" *Id.*, pg. 16. Even if this were true (in actuality, the handheld provides its own ID, the user enters a separate password and user name, see Kikinis col. 9, lines 55-58), Kikinis provides no teaching that the ID associated with the hand-held device is in any way related to the display of content on a desktop computer. At best, the portions of the Kikinis that have been newly cited by the Examiner merely describe providing information to a server from a wireless device that identifies a particular wireless device. However, such a teaching does not anticipate "*providing a mobile design element that corresponds to the form and is associated with the mobile wireless client device,*" where the "*form [] is used to display content on a desktop computer.*" For at least this reason, the rejection of claims 21, 26, 31, and 36 constitute legal error and should be overturned.

B. Claims 23, 28, 33, and 38

Claims 23, 28, 33, and 38 depend from independent claims 21, 26, 31, and 36, respectively. Therefore, the rejections of claims 23, 28, 33, and 38 based on Kikinis should be overturned at least for the reasons presented above, as well as for the features that they recite individually. For example, claims 23, 28, 33, and 38 are allowable over the cited portions of Kikinis at least for the reasons presented in the Appeal Brief at pages 7 and 8.

C. Claims 25, 30, 35, and 40

Claims 25, 30, 35, and 40 depend from independent claims 21, 26, 31, and 36, respectively. Therefore, the rejections of claims 25, 30, 35, and 40 based on Kikinis should be overturned at least for the reasons presented above, as well as for the features that they recite individually. For example, claims 25, 30, 35, and 40 are allowable over the cited portions of Kikinis at least for the reasons presented in the

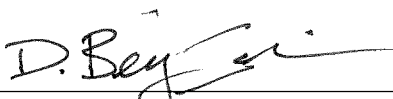
Appeal Brief at pages 8-10.

CONCLUSION

For at least the reasons provided above and in the Appeal Brief, Appellant respectfully requests that the rejection of each of pending claims 21-40 be reversed.

Date: ~~February~~ ^{March 5}, 2007

Respectfully submitted,

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